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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,490	07/02/2003	Harald Schlag	GP-301444	3525

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CARY W. BROOKS
General Motors Corporation
Mail Code 482-C23-B21
P.O. Box 300
Detroit, MI 48265-3000

EXAMINER

PARSONS, THOMAS H

ART UNIT	PAPER NUMBER
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1745

DATE MAILED: 10/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

5

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/612,490

Applicant(s)

SCHLAG, HARALD

Examiner

Thomas H. Parsons

Art Unit

1745

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 September 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-11, 22-27.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☒ Other: See Continuation Sheet.

PATRICK J. JOHNSON
SUPERVISOR
EXAMINER

Continuation of 13. Other:

Response to the Amendment.

This is in response to the Amendment filed 29 September 2006.

Claim Rejections - 35 USC § 112

The rejection of claims 11 and 12 under 35 U.S.C 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been withdrawn in view of Applicant's Amendment.

Double Patenting

The Issue of Double Patenting regarding claims 5 and 6 has been withdrawn in view of Applicant's Amendment.

Response to Arguments:

Applicant's arguments filed 29 September 2006 have been considered but they are not persuasive.

The Applicant argues on page 8 of the Remarks/Arguments, "Lemelson '941 discloses numerous products on which a diamond-like material may be deposited. However, of the estimated 100 plus possible products on which such a coating might be deposited, Lemelson never suggests placing such a coating on a fuel cell bipolar plate. Further, there is no evidence that Lemelson reduced any of these numerous possible devices to practice. The Lemelson disclosure is so broad that the statements therein can only be viewed as pure speculation. Notwithstanding the speculative nature of the disclosure, none of the disclosed devices suggest "a doped diamond coating or a doped diamond-like coating" on or over a fuel cell bipolar plate as recited in independent claims 1 and 25. There is no disclosure of a fuel cell bipolar plate in Lemelson and there is no suggestion that Lemelson coating could be substituted for other known fuel cell bipolar plate coatings with a reasonable expectation of success"

In response, Adhart et al. disclose coating a fuel cell bipolar plate constructed of e.g. aluminum with an anticorrosive material e.g. gold or other suitable materials wherein the material is non-limiting and can be selected by one skilled in the art (col. 3: 8-17 and 64-73). Lemelson also discloses coating surfaces e.g. aluminum with an anticorrosive material, specifically a doped diamond coating (see e.g. col. 8: 44-48)

In addition, the Examiner has relied upon Lemelson for its teaching that it is known in the art to coat surfaces similar in their material of construction to that taught in Adhart et al. with an anticorrosive material.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the gold coating of Adhart et al. with the doped diamond coating of Lemelson because both are concerned with coating an aluminum surface with an anticorrosive material.

The Applicant also argues on page 9, first paragraph, "... Thus, in order for the electrode to still function, the Lemelson synthetic diamond coating over the electrode must be porous to ensure that the reactant gases can flow through the synthetic diamond coating and into the electrode.

In response, the claim does not require coating the electrode. However, the porous nature of the coating on the electrode appears to be due to the porosity of the electrode material and not the coating itself. There is no teaching or suggestion in Lemelson that the coating is porous. Accordingly, substituting the coating of Adhart et al. with the coating of Lemelson would not appear to result in a bipolar plate coated with a porous synthetic doped diamond coating

Applicant argues on page 10, "...Because no equivalency between a gold coating and a doped diamond coating has been established with respect to the use of such coatings in a fuel cell environment, the Adhart '913 teaching of the use of a gold-coated aluminum material for bipolar plates actually teaches away from Applicant's claimed invention.

In response, both Adhart et al. and Lemelson are coating an aluminum surface with an anticorrosive material wherein the material of Adhart et al. is non-limiting. Accordingly, the Examiner has relied upon the teaching of Lemelson that it is known in the art to coat similar materials of construction with anticorrosive coatings. Therefore, substituting the coating of Adhart et al. with the coating of Lemelson would result in a bipolar plate coated with a doped diamond coating.